

REMARKS/ARGUMENTS

In response to the final rejection of claims 61-101 received from the Examiner on October 11, 2007, Applicants have filed this preliminary amendment in conjunction with a Request for Continued Examination. In addition to claims 61-101, Applicants submit herewith new claims 102-151 for consideration by the Examiner.

As set forth in the interview summary of August 14, 2007, the inventors, along with the assignee, an attorney of record and the Examiner discussed the importance of the elimination of the waist axis in a robot, as well as elevation and positioning of robots as applied to Applicants' novel MODULAR PAINTING APPARATUS. One focus of our discussion was how to present a negative limitation, such as "a robot not having a waist axis." A review of the Manual of Patent Examining Procedures (MPEP) discloses the following relevant guidelines.

MPEP Section 2173.05(i) Negative Limitations

The current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation. So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph. Some older cases were critical of negative limitations because they tended to define the invention in terms of what it was not, rather than pointing out the invention. Thus, the court observed that the limitation "R is an alkenyl radical other than 2-butenyl and 2,4-pentadienyl" was a negative limitation that rendered the claim indefinite because it was an attempt to claim the invention by excluding what the inventors did not invent rather than distinctly and particularly pointing out what they did invent. *In re Schechter*, 205 F.2d 185, 98 USPQ 144 (CCPA 1953).

A claim which recited the limitation "said homopolymer being free from the proteins, soaps, resins, and sugars present in natural Hevea rubber" in order to exclude the characteristics of the prior art product, was considered definite because each recited limitation was definite. *In re Wakefield*, 422 F.2d 897, 899, 904, 164 USPQ 636, 638, 641 (CCPA 1970). In addition, the court found that the negative limitation "incapable of forming a dye with said oxidized developing agent" was definite because the boundaries of the patent protection sought were clear. *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).

Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the

specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993). See MPEP § 2163 - § 2163.07(b) for a discussion of the written description requirement of 35 U.S.C. 112, first paragraph.

Applicants respectfully submit that newly presented independent claims 102, 115, 127, and 140 follow the examples set forth in *In re Wakefield*, 422 F.2d 897, 899, 904, 164 USPQ 636, 638, 641 (CCPA 1970) and *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971). Support for the negative limitation of no waist (Independent claims 102 and 115) may be found in the specification at page 10, line 11. Support for the robot operating with at least three major axes (Independent claims 127 and 140) and where the first axis is a linear axis and the second axis acts in a horizontal plane may be found in the specification at page 5, lines 3-5, page 8, lines 6-19 and Figure 5, reference numerals 34, 36, and 40- wherein the three axes: shoulder, elbow and rail- are the controlling axis, and the wrist axis 38 is an orientation axis.

With regard to the final rejection of previously considered claims 61-101, Applicants respectfully submit that none of the cited prior art, alone or in combination, teach the novel robot of Applicants' invention. Applicants restate support for this finding where: Takeo et al. discloses a floor mounted robotic system, Yamamoto et al. discloses a paint booth having the robot system located on the floor and the paint spray guns located alongside and overhead of the conveyor (Figure 15), Pearce teaches a well known gantry system, and Nuber, like Takeo et al. and Yamamoto, teaches floor mounted robots.

The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled in view of the prior art.

By amending the application, Applicants do not concede that the patent coverage available to them would not extend as far as the original claim. Rather, Applicants intend to file a continuation application to pursue the breadth of the claims as filed. Applicants believe that the Examiner has not made a sufficient showing of inherency of the teachings of the asserted prior art, especially given the lack of teachings in the cited references of the properties that Applicants have recited in their claims.

Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

CONCLUSION

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicants request that the Examiner contact the undersigned at (248) 960-2100.

If for some reason Applicants have not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 50-3156 for any fee which may be due.

THIS PAGE BLANK (USPTO)